

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-42 currently stand rejected. Claims 1, 3, 5, 7-10, 12, 15, 19, 21, 23, 25, 27-30, 32, 35, 39, and 41 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(e)

On page 7 of the Office Action, the Examiner rejects claim 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,006,039 to Steinberg et al. (hereafter 039). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that 039 fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21, as discussed below. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements

should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of 039 and Applicants' invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of the cited references.

Because a rejection under 35 U.S.C. §102 requires that every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite 039 to identically teach or suggest the claimed invention, Applicants respectfully request reconsideration and allowance of independent claim 42 so that this claim may issue in a timely manner.

35 U.S.C. § 103(a)

On page 8 of the Office Action, the Examiner rejects claims 1, 3-17, 21, and 23-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,477,264 to Sarbadhikari et al. (hereafter Sarbadhikari) in view of U.S. Patent No. 5,477,264 to Steinberg et al. (hereafter Steinberg). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Sarbadhikari according to the teachings of Steinberg would produce the claimed invention. Applicants submit that Sarbadhikari in combination with Steinberg fail to teach a number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Sarbadhikari nor Steinberg contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of independent claims 1 and 21, Applicants respond to the Examiner's §103 rejection as if applied to amended independent claims 1 and 21 which are now amended to recite "*said ancillary data module performing one or more on-line management procedures during which a system user interactively utilizes said imaging device to view, manipulate, select, and download said ancillary data files, said one or more on-line management procedures occurring while an active bi-directional communication path currently exists from said imaging device to said computer in said distributed computer*

network,” which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

Sarbadhikari teaches “an electronic camera for capturing and storing images in a removable storage device which is also preloaded with software for operating the imaging system (see column 2, lines 54-56). In contrast, Applicants affirmatively claim a data source that is “implemented as a computer in a distributed computer network.”

On pages 4 and 5 of the Office Action, the Examiner cites column 4, lines 40-49 of Sarbadhikari as support for rejecting Applicants’ claimed “on-line management procedures.” Applicants respectfully traverse. The “upstream modification of image data” discussed in Sarbadhikari occurs “during the capture and manipulation stages prior to storage” (see column 4, line 44), and is not part of any type of on-line management procedures.

Therefore, Applicants submit that Sarbadhikari nowhere discloses performing one or more on-line management procedures “*while an active bi-directional communication path currently exists,*” as claimed by Applicants. Furthermore, Applicants submit that Sarbadhikari fails to teach on-line management procedures “*during which a system user interactively utilizes said imaging device to view, manipulate, select, and download said ancillary data files,*” as claimed by Applicants.

On page 10 of the Office Action, the Examiner concedes, with regard to the teachings of Sarabadhikari, that “a data source being implemented as a computer in a distributed computer network is not taught.” Applicants concur. The

Examiner then points to Steinberg to purportedly remedy these deficiencies in Sarabadhikari. Applicants respectfully disagree with the Examiner's interpretation of the teachings of Steinberg.

Steinberg teaches a "communication device" that an electronic camera utilizes to send image data over an electronic network to a "remote computerized destination" (see column 1, line 44, through column 3, line 17). Steinberg explicitly refers to the network computer as a "destination" (see FIG. 1).

On page 3 of the Office Action, the Examiner maintains that Steinberg teaches receiving data from a remote destination. Applicants respectfully submit that Steinberg fails to provide any enabling discussion with regard to receiving data from a remote destination. For example, Steinberg nowhere provides any specific examples of what type of data might be received from the remote destination. In particular, Steinberg nowhere discloses downloading anything resembling Applicants' claimed "ancillary data files."

The primary data flow described in Steinberg (camera to network) is in the opposite direction to the primary data flow recited by Applicants (network to camera). Applicants therefore submit that Steinberg *teaches away* from their claimed invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987). For at least the foregoing reasons, Applicants respectfully submit that claims 1 and 21 are not unpatentable in light of the cited references.

Regarding the Examiner's rejection of dependent claims 3-17 and 23-37, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 3-17 and 23-37, so that these claims may issue in a timely manner.

In addition, Applicants have herein amended dependent claims 3, 5, 7-10, 12, 15, 23, 25, 27-30, 32, and 35, to remove claim language that presented certain limitations in the alternative. Applicants therefore respectfully request the Examiner to reconsider amended dependent claims 3, 5, 7-10, 12, 15, 23, 25, 27-30, 32, and 35 in light of the current amendments.

For at least the foregoing reasons, the Applicants submit that claims 1, 3-17, 21, and 23-37 are not unpatentable under 35 U.S.C. § 103 over Sarbadhikari in view of Steinberg, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1, 3-17, 21, and 23-37 under 35 U.S.C. § 103.

On page 14 of the Office Action, the Examiner rejects claims 2 and 22 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of

Steinberg and further in view of Examiner's Official Notice. The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 2 and 22, for at least the reasons that these claims are directly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2 and 22, so that these claims may issue in a timely manner.

In addition, with regard to the rejections of claims 2 and 22, the Examiner concedes that the cited references fail to teach "a system wherein said data source includes an image station site on an Internet network." The Examiner then takes Official Notice "regarding the equivalency of a computer in a distributed computer network and an image station site on an Internet network" as support for the rejections without providing any specific references for support.

Applicants submit that the cited references fail to disclose either an "image

station site” or an “Internet network” as recited in claims 2 and 22. Applicants further submit that “image station site” would not have been obvious to a person of normal in the art, at the time of the invention. Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 2 and 22 so that the present Application may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.” In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that there is no teaching of a combination that would result in Applicants’ invention, and therefore the obviousness rejection under 35 U.S.C §103 is not proper.

Applicants submit that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicants’ invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicants therefore respectfully request the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found. Alternately, the Applicants request that the Examiner reconsider and withdraw the rejections of claims 2 and 22 under 35 U.S.C §103.

For at least the foregoing reasons, the Applicants submit that claims 2 and 22 are not unpatentable over the cited references, and that the rejections are thus

improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 2 and 22 so that these claims may issue in a timely manner.

On page 15 of the Office Action, the Examiner rejects claims 18-20 and 38-41 under 35 U.S.C. § 103 as being unpatentable over Sarbadhikari in view of Steinberg and further in view of U.S. Patent No. 6,177,957 to Anderson (hereafter Anderson). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 18-20 and 38-40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 18-20 and 38-40, so that these claims may issue in a timely manner.

Furthermore, with regard to claims 18 and 38, the Examiner concedes that Sarbadhikari fails to teach an “off-line management procedure including a file descriptor identification procedure” Applicants concur. The Examiner then points to Anderson to purportedly remedy these deficiencies. Anderson is limited to teaching a camera device that accesses “executable files” from a “flash disk”. Applicants therefore submit that neither Anderson, Sarbadhikari, nor Steinberg teach a “data source being implemented as a computer in a distributed computer network,” as claimed by Applicants. Applicants further submit that neither Anderson, Sarbadhikari, nor Steinberg teach “*performing one or more on-line management procedures during which a system user interactively utilizes said imaging device to view, manipulate, select, and download said ancillary data files, said one or more on-line management procedures occurring while an active bi-directional communication path currently exists from said imaging device to said computer in said distributed computer network,*” as claimed by Applicants.

Independent claim 41 has been amended herein to recite elements and functionality similar to those recited in claim 21, as discussed above. Applicants therefore incorporate those prior remarks by reference with regard to claim 41.

For at least the foregoing reasons, the Applicants submit that claims 18-20 and 38-41 are not unpatentable over the cited references, and that the rejections are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 18-20 and 38-41 so that these claims may issue in a timely manner.

Summary

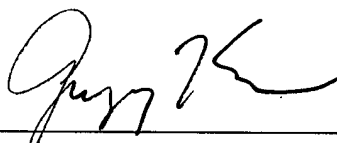
Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-42 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

Date: _____

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By: _____



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